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Donald H. Osterberg JR.

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ORACLE C/O MURABITO, HAO & BARNES LLP
TWO NORTH MARKET STREET
THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER

WHIPPLE, BRIAN P

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/698,813	Applicant(s) OSTERBERG, DONALD H.	
	Examiner BRIAN P. WHIPPLE	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-2, 4-9, and 11-20 are pending in this application and presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/23/08 has been entered.

Response to Arguments

3. Applicant's arguments filed 10/23/08 have been fully considered but they are not persuasive.

4. As to claim 1, Applicant argues the Goldman reference fails to disclose an authorization indicator. The Examiner respectfully disagrees. Goldman discloses sending an authorization request, or indicator, to the purported sender address, and correspondingly the sender responding to said request ([0063]). Goldman also discloses such an authorization

check being done by an administrator verifying authorization of a purported sender and therefore indicating a valid address through authorization ([0063]). Furthermore, Kaminski discloses an authorization indicator (Kaminski: [0036], lines 10-12)."

The language of the claim does not specify the type of authorization indicator. An indicator that an authorization procedure is in progress is an authorization indicator. Furthermore, Applicant appears to argue that the request of Goldman alone may not be viewed as an authorization indicator as a response must be sent back by the recipient and that is the indicator. However, an authorization indicator may be either an indication that a recipient is authorized or unauthorized. Goldman specifically mentions that if no response is received, the authorization fails and the request to forward the electronic message will not be carried out ([0063] – [0064]). In other words, the authorization request may be viewed as an authorization indicator, because if the sender's address is spoofed, no response is received yet a decision regarding authorization is still made. Given the absence of any recipient, the request must be the authorization indicator, as nothing else is present in this scenario. Additionally, as discussed, the Examiner fails to see how an indication of an authorization procedure being in progress cannot be construed as an authorization indicator for the purposes of an obviousness rejection under 35 U.S.C. 103.

The Examiner feels the claim language would have to be amended to specifically claim the authorization indicator as an indication that authorized has occurred (past tense) as

opposed to the language of the current claim of an indicator of authorization. Furthermore, Applicant's own claim includes the verification of a source address occurring using the authorization indicator. Since the authorization indicator is sent prior to the verification, this would support the Examiner's interpretation of the authorization request reading on an authorization indicator.

5. As to claims 2, 4-9, and 11-20, Applicant argues the claims are allowable based on the allowability of claim 1. However, the Examiner has refuted the allowability of claim 1 above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4-9 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminski et al. (Kaminski), U.S. Publication No. 2005/0044155 A1, in view of Goldman, U.S. Publication No. 2003/0233418 A1.

8. As to claim 1, Kaminski discloses an unsolicited e-mail internet protocol source address verification method (Abstract, ln. 1-3) comprising:

receiving a request for authorization to forward an electronic mail message ([0032], ln. 1-2; [0034], ln. 1-4 and 9-15);

responding to said request for authorization to forward said electronic mail message ([0035], ln. 1-3 and 8-10), wherein a response to said request for authorization includes an authorization indicator that indicates a source of said request for authorization (Kaminski: [0036], lines 10-12); and

handling receipt of said electronic mail message (Fig. 10, item 450).

Kaminski is silent on verifying the source address included in the received said electronic mail message against the address the authorization indicator is sent to.

However, Goldman discloses verifying the source address included in the received said electronic mail message against the address the authorization indicator is sent to ([0063]; the purported address is verified against itself or the manager's address through the use of an authorization request for indicating authorization).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kaminski by verifying the source address of an electronic mail message against the given address or a manager's address as taught by Goldman in order to detect spoofed sender addresses, the occurrence of which typically

indicates junk e-mail (Goldman, [0063], lines 11-14) and/or allow a manager to control whom is classified as unauthorized in a mail system (Goldman: [0063]).

9. As to claim 2, Kaminski and Goldman disclose the invention substantially as in parent claim 1, including said request is initiated by a source of said electronic mail message (Kaminski: Figure 7, item 258 of SENDER'S MAIL CLIENT 14; [0034], lines 9-15) and said request asks a simple mail transfer protocol agent for authorization to send an electronic mail message to a destination serviced by said simple mail transfer protocol agent (Kaminski: [0036], lines 1-4).

10. As to claim 4, Kaminski and Goldman disclose the invention substantially as in parent claim 1, including said authorization indicator is send to a source address identified in said request (Kaminski: Figure 7, item 268; [0036], lines 10-12).

11. As to claim 5, Kaminski and Goldman disclose the invention substantially as in parent claim 1, including performing an indication generator process in which an authorization indicator is generated (Kaminski: Figure 7, item 268; [0036], lines 10-12).

12. As to claim 6, Kaminski and Goldman disclose the invention substantially as in parent claim 5, including said authorization indicator is a unique bit string (Kaminski: [0044], lines 1-3; [0045], lines 8-11).

13. As to claim 7, Kaminski and Goldman disclose the invention substantially as in parent claim 1, including tracking said source address (Kaminski: [0036], lines 4-9).

14. As to claim 8, Kaminski and Goldman disclose the invention substantially as in parent claim 1, including inserting an entry into said electronic mail message indicating said address said authorization indicator is sent to before forwarding said electronic mail message to an end use destination (Kaminski: [0046], lines 13-20).

15. As to claim 9, Kaminski and Goldman disclose the invention substantially as in parent claim 1, including extracting a request source address from said request (Kaminski: [0034], lines 9-15; [0035], lines 1-3); and

utilizing said request source address as a destination address in a header file of a return package including authorization indicator information (Kaminski: [0022], lines 20-23; [0025], lines 3-4; [0035], lines 1-3; [0036], lines 10-12).

16. As to claims 11 and 17, the claims are rejected for the same reasons as claim 1 above.

17. As to claim 12, Kaminski and Goldman disclose the invention substantially as in parent claim 11, including said instructions direct determination of electronic message authorization (Kaminski: Page 8, left column, line 47; [0032], lines 1-2; [0034], lines 1-4 and 9-15).

18. As to claim 13, Kaminski and Goldman disclose the invention substantially as in parent claim 11, including said instructions include:

formulating a request for permission to forward an electronic message including a permission request source address (Kaminski: Figure 7, item 258; [0034], lines 9-15);

analyzing said request for permission (Kaminski: [0035], lines 1-3; [0036], lines 1-4);

sending a permission reply to said permission request source address (Kaminski: [0036], lines 10-12);

forwarding an electronic message, including said permission indicator in a header (Kaminski: [0044], lines 1-3; [0045], lines 8-11; [0046], lines 13-20); and

tracking said permission request source address and a source address of said electronic message when received (Kaminski: [0036], lines 4-9).

19. As to claim 14, Kaminski and Goldman disclose the invention substantially as in parent claim 13, including a message initiator inserts an indication in a header of a communication packet that said initiator is attempting to establish a communication link for a purpose of forwarding a message to a particular destination (Kaminski: [0038], lines 1-11), said header also includes an indication of an initiator or source address (Kaminski: [0025], lines 3-5).

20. As to claim 15, Kaminski and Goldman disclose the invention substantially as in parent claim 13, including said permission reply includes a permission indicator (Kaminski: [0036], lines 10-12).

21. As to claim 16, Kaminski and Goldman disclose the invention substantially as in parent claim 15, including a time stamp is maintained of when said permission indicator is generated (Kaminski: [0046], lines 5-11).

22. As to claim 18, Kaminski and Goldman disclose the invention substantially as in parent claim 17, including transmitting a request to send said unsolicited electronic message, wherein said request includes a request sender's identification (Kaminski: [0032], lines 1-2; [0034], lines 1-4 and 9-15).

23. As to claim 19, Kaminski and Goldman disclose the invention substantially as in parent claim 18, including said request is transmitted to a simple mail transfer protocol agent and said simple mail transfer protocol agent forwards a verification indicator to a request sender's source address (Kaminski: [0034], lines 9-15; [0035], lines 1-3).

24. As to claim 20, Kaminski and Goldman disclose the invention substantially as in parent claim 19, including said verification indicator is a unique bit string (Kaminski: [0044], lines 1-3; [0045], lines 8-11).

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892). The various arts cited relate to authorizing senders of electronic messages. For example, Katsikas, U.S. Publication No. 2005/0188045 A1 discloses the sender address of an electronic mail message being verified against a list of approved senders (Abstract). Therefore, the address of the sender is an authorization indicator.

26. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (10:30 AM to 7:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple
/B. P. W./
Examiner, Art Unit 2452
10/28/08

/Kenny S Lin/
Primary Examiner, Art Unit 2452